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EXAMINER

TRAN, PHILIP B

ART UNIT

PAPER NUMBER

2155

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Please find below and/or attached an Office communication concerning this application or proceeding.



## **Response to Amendment**

### ***Notice to Applicant***

1. This communication is in response to amendment filed 31 October 2005. Claims 2-3, 16-17 and 30-31 have been amended. Therefore, claims 1-31 are pending for further examination.

### ***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-31 are rejected under 35 U.S.C. § 102(e) as being anticipated by Smith et al (Hereafter, Smith), U.S. Pat. No. 6,697,842.

Regarding claim 1, Smith teaches a method comprising:

transferring a proper subset of a first plurality of information items and receiving at least one information item separate from the first plurality of information items (= transferring data from the server to the mobile client via a service provider) [see Abstract and Fig. 1]; and

forming a second plurality of information items including the first plurality of information items and the at least one information item and processing the second

plurality of information items, providing at least one dynamically processed information item (= dynamically processing and filtering data for adapted content being sent to the mobile client) [see Abstract and Fig. 4 and Col. 4, Line 25 to Col. 5, Line 36].

Regarding claims 2-3, Smith further teaches the method of claim 1 wherein processing comprises prioritizing and wherein prioritizing, further comprises transferring, in prioritized order, at least two dynamically processed information items (= filtering and prioritizing) [see Col. 2, Lines 1-25].

Regarding claim 4, Smith further teaches the method of claim 1 wherein the second plurality of information items comprises a complement of the proper subset of the first plurality of information items, the complement comprising information items within the first plurality of information items that are not in the proper subset of the first plurality of information items [see Fig. 9 and Col. 4, Line 25 to Col. 5, Line 36].

Regarding claims 5-6, Smith further teaches the method of claim 1 wherein the first plurality of information items is heterogeneous and wherein the second plurality of information items is heterogeneous (= web-based forms) [see Col. 7, Lines 1-34].

Regarding claims 7-8, Smith further teaches the method of claim 1, wherein at least one of the first plurality of information items is received from a user input and

wherein at least one of the second plurality of information items is received from a user input [see Col. 5, Line 37 to Col. 6, Line 67].

Regarding claims 9-10, Smith further teaches the method of claim 1, wherein at least one of the first plurality of information items is received from a separate second device and wherein at least one of the second plurality of information items is received from a second device [see Col. 4, Line 25 to Col. 5, Line 36].

Regarding claim 11, Smith further teaches the method of claim 1 further comprising promoting a dynamically processed information item to a user-accessible state [see Abstract].

Regarding claim 12, Smith further teaches the method of claim 1, wherein when processing comprises prioritizing, providing includes presenting in prioritized order [see Abstract].

Regarding claims 13-14, Smith further teaches the method of claim 1 further comprising transferring a dynamically processed information item to a separate second device and intra-device transferring a dynamically processed information item [see Col. 2, Lines 1-25 and Col. 4, Line 25 to Col. 5, Line 36 ands Col. 7, lines 45-67].

Claims 15-28 are rejected under the same rationale set forth above to claims 1-14, respectively.

Claims 29-31 are rejected under the same rationale set forth above to claim 1-3, respectively.

### ***Response to Arguments***

4. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 1, 15 and 29 such as "receiving at least one information item separate from the first plurality of information items".

Therefore, claims 1, 15 and 29 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations. Also, undue experimentation would be needed to receive at least one information item separate from the first plurality of information items.

*In response to applicant's arguments, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. See **Colman v. Kimberly-Clark Corp.**, 218 USPO 789.*

Smith teaches a method comprising transferring a proper subset of a first plurality of information items and receiving at least one information item separate from the first plurality of information items. For example, Smith discloses transferring data from the server to the mobile client via a service provider. Since a filtering process involved, then there is a step of receiving at least one information item separate from the first plurality of information items [see Smith, Abstract and Fig. 1 and Col. 2, Lines 7-24 and Col. 4, Line 65 to Col. 5, Line 18]. In addition, Smith further teaches forming a second plurality of information items including the first plurality of information items and the at least one information item and processing the second plurality of information items, providing at least one dynamically processed information item. For example, Smith further discloses dynamically processing and filtering data for adapted content being sent to the mobile client. Since data are gathered/collected, then there is a step of forming a second plurality of information items including the first plurality of information items and the at least one information item [see Smith, Abstract and Fig. 4 and Col. 1, Lines 24-46 and Col. 4, Line 25 to Col. 5, Line 36].

As a result, cited prior art does disclose a system and method as broadly claimed by the applicant. Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter recited in independent claims 1, 15 and 29. Dependent claims are also rejected at least by virtue of dependency on independent claims and by other reasons shown above. Accordingly, claims 1-31 are respectfully rejected.

***Conclusion***

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

**A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.



7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip B. Tran  
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Art Unit 2155  
March 02, 2006